REMARKS

In response to the Office Action dated April 28, 2003, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims. The continued indication that claims 109-117 have been allowed, and that others of the claims contain allowable subject matter, is noted with appreciation.

Overview

All of the remaining claims were rejected under 35 U.S.C. § 103, on the grounds that they were considered to be unpatentable over the Selker patent in view of the Carpendale et al. publication, either by themselves or in combination with other references. In their previous response, Applicants traversed these rejections on the grounds that the Office Action failed to provide the following elements that are required for a rejection under 35 U.S.C. § 103, as set forth in MPEP § 706.02(j):

> (1) The proposed modification of the applied references necessary to arrive at the claimed subject matter, and
>
> (2) An explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

It is respectfully submitted that the most recent Office Action still fails to satisfy these requirements. The response to Applicants' arguments does not even address the first of these requirements. Specifically, the Office Action does not provide any indication of the manner in which the teachings of the Carpendale publication are being applied to the

icon menu of the Selker patent. As discussed in detail below, the Carpendale publication is directed to a problem that is not present in the icon menu of the Selker patent. The Office Action identifies the respective teachings of the individual references, but does not explain *how* the teachings of one are to be applied to the other. It is respectfully submitted that such a showing is necessary to support a *prima facie* case of obviousness.

More importantly, given the fact that the two references are directed to entirely disparate areas of technology, it is not apparent *why* a person of ordinary skill in the art would have any inclination to combine their teachings. Again, the Office Action merely refers to the individual teachings of the references, but does not provide any *reason* for applying the teachings of one to the other. As noted in applicant's previous response, MPEP § 2143 explicitly requires that the "teaching or suggestion to make the claimed combination...must...be found in the prior art, not in Applicants' disclosure," citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Office Action has not identified any teaching in either of the references, or elsewhere in the prior art, that would lead one to apply the distortion function of the Carpendale publication to the icon menu of the Selker patent. Without such a showing, the Office Action fails to provide the proper support for the rejection.

The Teachings of the Reference

The Selker patent is directed to a graphical user interface for a computer. Referring to Figure 1, it discloses a menu 30 containing a one-dimensional array of icons. The patent is particularly concerned with the tradeoffs between required display area and ease of user

visibility when a large number of icons are to be displayed. To address this concern, the patent discloses a technique wherein the distance between the icon menu 30 and a cursor 20 is computed, and when the vertical component of this distance falls below a threshold level, the icon closest to this cursor is identified. The display of this nearest icon is then increased in size, as depicted in Figure 2. As the cursor is moved closer to the icon menu, the size of the identified icon is increased by a greater amount, as illustrated in Figure 3a.

In contrast, the Carpendale publication is not directed to the components of a graphical user interface, such as an icon menu. Rather, it is directed to techniques for viewing data that is displayed in a *three-dimensional* representation. The following passage from page 46, right column, second full paragraph, is illustrative of the environment to which the Carpendale publication is directed:

> Inherent in working with data in 3D is the fact that some data will be *buried* within a structure, whether a solid model or a complicated 3D graph layout, and hence *visually inaccessible*. Previous work provides access to the *internal* details of such structures through the use of cutting planes, layer removal and transparency. We describe a novel solution to this *problem of internal access* with the introduction of a distortion function which creates a clear *line of sight* to a focus revealing sections that had been previously obscured. (emphasis added)

From this passage, it can be seen that the Carpendale publication is concerned with the user's ability to view data that is *hidden* from view in a three dimensional arrangement. The publication describes the use of a distortion function to create a "clear line of sight" to buried data that had been "previously obscured." In essence, the purpose of the distortion function is to move the data in the outer layers of the 3D representation out of the way, so that inner data can be viewed.

Lack of Relationship Between References

The icon menu of the Selker patent does not exhibit the type of problem to which the Carpendale publication is directed. This is due to the fact that the icons are arranged in a one-dimensional array. They are all visible to, and accessible by, the user at all times, and hence there is no problem of "buried" or "obscured" data. Thus, there is no need to employ a distortion function to move some of the items out of the way in order to view other items, as in the case of the three dimensional data described in the Carpendale publication.

Since the Carpendale publication is directed to a problem that is not even present within the icon menu of the Selker patent, *why* would a person of ordinary skill in the art, who is designing a graphical user interface of the type taught in the Selker patent, be at all motivated to look to the teachings of the Carpendale publication? This question remains unanswered in the Office Action. The rejection does not identify any teachings in either of the two references that would provide a reason to apply the distortion function of the Carpendale reference to the icon menu of the Selker patent.

In view of the foregoing reasons, it is respectfully submitted that the Office Action does not meet the requirements for a *prima facie* case of obviousness. If the rejection is not withdrawn, the Examiner is respectfully requested to explain:

(1) *how* the teachings of the Carpendale publication are to be applied to the icon menu of the Selker patent;

(2) the reasons *why* a person of ordinary skill in the art would want to combine the teachings in such a manner; and

(3) *where* the references teach such reasons.

In the absence of such showings, it is respectfully submitted that the rejections should be withdrawn.

In addition to pointing out the lack of a basis for combining the teachings of the two references, Applicants' prior response also presented arguments that, even if the teachings of the two references could somehow be combined, the result would still not be the same as the subject matter recited in a number of the claims. For example, it was pointed out that claim 5 recites that the processor "repositions said *others* of said plurality of tiles" in accordance with a predefined relationship between an effect width W, a default height h and a selected maximum height H. The rejection of claim 5 refers to icons E and P in Figure 5 of the Selker patent, and the use of the Pythagorean theorem to calculate the distances between the icons and the cursor. It is not apparent from the Office Action how this teaching relates to the subject matter of the claims, however. Where does the patent teach that the other icons, e.g., icons G-O, are repositioned, particularly in accordance with parameters such as an effect width, a default height and a maximum height? The Office Action fails to provide any relationship between the disclosure of the patent and the claimed subject matter.

Similarly, with respect to claims 12-15, 21 and 120, Applicants' previous response identified features recited in these claims that are not apparent from the teachings of the references, even when combined. Again, the most recent Office Action does not address any of these points raised by Applicants.

Finally, with respect to the arguments pertaining to claim 128, presented in the Amendment filed April 22, 2003, the Office Action states "Selker teaches that the size of a menu item is expanded in inverse proportionate relationship to the proximity of the cursor from a default height (e.g., h) to a fixed maximum level. For example, when distance = 8, height = h+1; when distance = 4, height = h+2; when distance = 2, height = maximum level." This explanation does not address the subject matter recited in the *claim*. Specifically, claim 128 says that the height of one of the items is increased from the default height to a fixed maximum level "upon detecting that the cursor is within said threshold distance." The claim goes on to recite the step of "maintaining said height at said fixed level while said cursor is equal to or less than said threshold distance from said one item." The explanation provided in the Office Action does not equate to the claim recitation. To illustrate, if the threshold distance is equal to 8, the size of the menu icon does not increase from the default height h to the maximum level. Rather, it only goes from h to h+1. Thereafter, if the cursor is moved closer, the height of the icon is not maintained at that level. Rather, it continues to increase.

Conversely, if the threshold distance is 2, the size of the menu icon does not increase "from" the default height h to the maximum height. Rather, it starts from the height of the prior level, e.g. h+2. As pointed out in Applicants' previous response, the Selker patent does not contain any teaching that the size of an icon increases *from* the default size *to* the maximum size "upon detecting that the cursor is within said threshold distance."

In view of the foregoing, it is respectfully submitted that the rejections of a number of the claims have not properly taken into account the specific subject matter recited in those claims. When the recitations of the claims are compared against the teachings of the Selker and Carpendale references, it is apparent that the references do not suggest the claimed subject matter, even if their teachings could somehow be combined.

In view of the foregoing, it is respectfully submitted that the Office Action has failed to meet all of the requirements for a *prima facie* case of obviousness. Furthermore, it does not identify where the specific features of a number of the claims are taught by the references. Reconsideration and withdrawal of the rejections, and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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